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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,783	12/30/1999	DONALD K. NEWELL	2207/6929	2707
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KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005				
			EXAMINER NALEVANKO, CHRISTOPHER R	
			ART UNIT	PAPER NUMBER

2611

DATE MAILED: 02/25/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/474,783

Applicant(s)

NEWELL ET AL.

Examiner

Christopher R Nalevanko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/03 has been entered.

### ***Response to Arguments***

1. Applicant's arguments filed 10/27/2003 have been fully considered but they are not persuasive. Regarding Claim 1, Applicant argues that "...the Russo patent does not disclose or suggest sending control information embedded in the broadcast content where the 'embedded control information defines an action to be taken pertaining to the broadcast content' as recited in claim 1... Contrary to the Examiner's assertion, while an authorization key and compression information may be control information that specifies how to do something, they do not 'define actions to be taken pertaining to the broadcast content,' as recited in claim 1" (page 7 lines 5-20). Examiner asserts that specifying how to do something and defining an action (which is doing something), is the same. The authorization codes and descrambling keys shown in Russo define how the broadcast content will be decrypted and descrambled so that the data can be used by the receiver.

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2. Applicant's arguments with respect to the control information being 'embedded in the broadcast' have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo.

Regarding Claim 1, Russo shows a system for controlling use of broadcast content comprising a receiver in communications with a source of broadcast content and a playback device, wherein the receiver is configured to control the use of the received broadcast content through the playback device in accordance with control information in the received broadcast content (col. 3 lines 3-28 and 50-60, col. 6 lines 12-25, col. 8 lines 55-67, see figure 2). Furthermore, the authorization key and compression algorithms directly define actions or operations to be taken pertaining the broadcast data. Although Russo shows that the control information is in the broadcast content stream (col. 8 lines 65-67, col. 9 line 1), he fails to specifically state that this control information is embedded in the content. Official Notice is given that it is well known and expected in the art to embed control information in broadcast content. This allows providers to send a variety of programming control data and additional information with the broadcast

content without requiring an additional transmission means. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Russo to embed the control information so that bandwidth was conserved and an additional communications medium was not necessary.

Regarding Claim 2, Russo shows that a storage device is couple to the receiver (col. 3 lines 3-20, see figure 1 item 14 'program storage').

Regarding Claim 3, shows that the receiver can store broadcast content in the storage devise based on the control information (col. 3 lines 12-20, col. 4 lines 45-67, col. 6 lines 12-25, col. 9 lines 38-67).

Regarding Claim 4, Russo further shows that the receiver is configured to maintain information relating to the use of the received broadcast content (col. 3 lines 20-25, col. 5 lines 48-65).

Regarding Claim 5, Russo shows that the receiver is configured to use the information relating to the use of the received broadcast content for remuneration of a provider of content (col. 4 lines 45-67, col. 5 lines 20-33, col. 6 lines 34-55).

Regarding Claim 6, Russo shows that the information relating to the use of the received broadcast content comprises a duration of use (col. 5 lines 32-47).

Regarding Claim 7, Russo shows a method for controlling the use of broadcast content comprising receiving broadcast content, extracting control information from the received broadcast content (col. 6 lines 12-32, col. 8 lines 55-67), and controlling the use of the received broadcast content in accordance with the extracted control information (col. 6 lines 12-32, col. 9 lines 48-67, col. 5 lines 34-60, col. 4 lines

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45-67). Furthermore, the authorization key and compression algorithms directly define actions or operations to be taken pertaining the broadcast data. Although Russo shows that the control information is in the broadcast content stream (col. 8 lines 65-67, col. 9 line 1), he fails to specifically state that this control information is embedded in the content. Official Notice is given that it is well known and expected in the art to embed control information in broadcast content. This allows providers to send a variety of programming control data and additional information with the broadcast content without requiring an additional transmission means. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Russo to embed the control information so that bandwidth was conserved and an additional communications medium was not necessary.

Regarding Claim 10, Russo shows that control information indicates a length of time that the received broadcast content may be consumed (col. 5, lines 32-46).

Regarding Claim 11, Russo shows that control information indicates a time period during which the received broadcast content may be consumed (col. 5, lines 32-46).

Regarding Claim 12, Russo shows that the video can be saved for a predetermined length of time but doesn't specifically state a date range (col. 5, lines 32-46). It is nonetheless inherent that this time period would be more than one day, thus covering a range of dates.

Regarding Claim 13, it is inherent that the information sent to the user site would include billing information (col. 6 lines 10-27).

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Regarding Claim 14, it is inherent that the information sent to the user site would contain information for the cost of consuming the broadcast (col. 6 lines 10-27).

Regarding Claim 15, Russo shows the ability to “unlock” certain viewing options with a code sent along with the video stream (col. 6 lines 10-27). This inherently prevents the unjustified use of the broadcast material since other options would remain locked.

Regarding Claim 16, Russo shows obtaining payment information from the user (col. 6 lines 20-28, lines 35-46, col. 10 lines 10-48).

Regarding Claim 17, Russo shows communicating consumption information to a billing facility (col. 6 lines 34-53, col. 10 lines 10-48).

Regarding Claim 18, Russo shows that the billing facility comprises a facility maintained by a provider of the broadcast content (col. 6 lines 20-36).

Regarding Claim 19, Russo shows a storage medium containing a set of instructions for execution by a computer (see figure 2 items 136, 156, 150, 158). This clearly shows that the invention of Russo is capable of being carried out by a computer controlled medium. All further limitations of the Claim have been addressed in Claim 7.

Regarding Claim 20, it is further understood that the memory shown in Russo is accessible by a computer.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo.

Regarding Claim 9, Russo does show lengths of time and days that the broadcast may be viewed (col.5 lines 33-48). Russo fails to show that the control information indicates the number of times the received broadcast content may be consumed. Limiting the number of times is a logical variation of the restriction of viewing already set forth by Russo and therefore would have been obvious to one of ordinary skill in the art at the time the invention was made. This would enable the broadcast facility to supply the viewer with various pricing and viewing options.

Regarding Claim 21, Russo fails to show that the storage medium comprises a portable storage device. Official Notice is taken that it is well known and expected in the art to use removable storage devices, such as CD-ROMs or removable hard drives. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Russo with a portable storage device so that the instructions could be transported to other systems.

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4.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russo in further view of Horton et al.

Regarding Claim 8, Russo fails to teach that the control information comprises authorization to store the received broadcast content. Horton teaches a code that is sent to the receiver that indicates whether a program may be stored or not (col. 2 lines 30-38). It would have been obvious to one of ordinary skill in the art at the time the invention



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was made to modify the system of Russo with the restrictive storing of Horton so that programs that were not intended to be stored could not be recorded by the user.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Nalevanko whose telephone number is 703-305-8093. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Christopher Nalevanko  
AU 2611  
703-305-8093

cn  
February 20, 2004

  
PATENT EXAMINER